

REMARKS

The following remarks are submitted to address the above amendments and issues raised in the Official Action mailed November 14, 2003.

A Request for Extension of Time for three months, extending the time in which to respond to this Official Action to May 14, 2003, along with the appropriate fee, is submitted herewith.

Upon entry of the foregoing amendments, claims 1-5, 7-18, 20-29, and 31-34 are pending in this application. Claims 1-5, 7, 9-12, 14-18, 20, 22-25, 27-29, and 32-34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Berger (U.S. Patent No. 5,084,988). Claims 8, 13, 21, 26, and 31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Berger in view of either Rosen (U.S. Patent No. 4,931,773) or Sigoloff (U.S. Patent No. 4,712,314).

These amendments are made merely to clarify the subject matter of this application. No new matter has been added. Support for requested amendments can be found in the original claims and throughout the present specification and drawings. Applicant respectfully requests consideration of the application in light of the above amendments and the following remarks.

Summary of Interview

Applicant thanks Examiner Marie D. Patterson for her telephone interview with the undersigned on May 11, 2004, in which features of the claims were discussed. Particular aspects of the present invention discussed include the lack of a transparent outsole in the claims as disclosed by Berger, a heel placement indicator positioned on the outsole in alignment with the inside heel portion, and a range of shoe sizes for determining a numerical shoe size as disclosed in the present specification and drawings.

Claims 1-5, 7, 9-12, 14-18, 20, 22-25, 27-29, and 32-34—35 USC § 103(a)

The rejections of claims 1-5, 7, 9-12, 14-18, 20, 22-25, 27-29, and 32-34 under 35 U.S.C. § 103(a) as being unpatentable over Berger are respectfully traversed.

Claims 1, 14, and 27, as amended, claim a shoe for determining a proper numerical shoe size for a person's foot, a shoe size indication system, and a method for determining a proper numerical shoe size for a person's foot in which "the shoe sizes corresponding to the plurality of shoe size indicators comprise *a range of standardized shoe sizes that approximate a size of the shoe.*" (Claims 1, 14, and 27, emphasis added.) Claims 12, 25, and 34, as amended, claim a shoe for determining a proper numerical shoe size for a person's foot, a shoe size indication system, and a method for determining a proper numerical shoe size for a person's foot in which "the shoe sizes corresponding to the plurality of shoe size indicator lines comprise *a range of standardized shoe sizes and lengths and widths suitable for toddlers, pre-schoolers, girls, boys, women, or men.*" (Claims 12, 25, and 34, emphasis added.)

The Official Action states that Berger shows shoe soles and methods of using shoe soles having a heel indicator and a plurality of calibrated lines with indicia comprising calibrated numbers and/or lines substantially as claimed except for the exact indicia, that standard shoe sizes are a type of well known and conventional calibrated marking, and that it would have been obvious to use any calibrated markings, including the well known and conventional shoe size calibrated markings, for the calibrated indicia on the shoe sole and in the method of Berger to allow the user to easily locate a shoe in the right shoe size range. (Official Action, para. 2.)

Berger discloses a shoe having a front transparent area within the outsole with calibrated markings, such as lines and/or numbers, that form a warning zone for indicating that a shoe has become too small. The shoe can also have a rear transparent area within the outsole through which heel location can be observed. The markings allow monitoring of the distance of the toe tips from the upper tip to see whether the shoe has become too small. (Berger, col. 1, line 38 –

col. 2, line 4; col. 3, lines 1-11.) A nontransparent edge in the front sole area can be used for calibration or marking of the “correct shoe size” by observing whether toe tips are present in the transparent area or grown into the nontransparent area. (Berger, col. 3, lines 62-68.)

“To establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” (MPEP § 2143.03.) Nowhere does Berger disclose “*a range of standardized shoe sizes that approximate a size of the shoe*”, as in claims 1, 14, and 27 of the present invention. Nowhere does Berger disclose “*a range of standardized shoe sizes . . . suitable for toddlers, pre-schoolers, girls, boys, women, or men*”, as in claims 12, 25, and 34 of the present invention. In contrast, Berger discloses a shoe having a front transparent area within the outsole with calibrated markings, such as lines and/or numbers, that form a *warning zone* for indicating that a shoe has become too small. As a result, Berger fails to disclose all the claim limitations of claims 1, 12, 14, 25, 27, and 34 of the present invention. Therefore, Applicant respectfully submits that claims 1, 12, 14, 25, 27, and 34 are not obvious in view of Berger. Claims 2-5, 7, 9-11, 15-18, 20, 22-24, 28-29, and 32-33 depend from claims 1, 12, 14, 25, and 27, and are therefore also not obvious in view of Berger.

“The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure.” (MPEP § 2142.) Applicant respectfully submits that there is no suggestion or motivation in Berger to modify its teachings to achieve “*a range of standardized shoe sizes that approximate a size of the shoe*”, as in claims 1, 14, and 27 of the present invention, or “*a range of standardized shoe sizes . . . suitable for toddlers, pre-schoolers, girls, boys, women, or men*”, as in claims 12, 25, and 34 of the present invention. The present invention provides for determining the proper numerical shoe size for a person’s foot that includes utilizing a range of standardized shoe sizes, including half sizes, as shown in Figs. 1-8, and in the shoe size tables on pages 11-13 of the present specification. Such a range can include a range of standardized shoe sizes for a particular age group, for example, toddlers, pre-schoolers, girls, boys, women, or men. (Present specification, page 15, line 20 – page 16, line 23.) In contrast, Berger teaches a *warning*

zone for indicating that a shoe has become too small, without respect to a particular shoe size or range of shoe sizes. Therefore, Applicant respectfully submits that Applicant's invention as claimed would not have been obvious to one having ordinary skill in the art with respect to Berger.

The Official Action states Berger shows features of the present invention substantially as claimed except for the exact indicia, and that claims are allowed only where they define either new features of structure or new relations of printed matter to structure, which new features or new relations give rise to some new and useful function, effect, or result. (Official Action, para. 2.) Applicant respectfully submits that shoe size indicators and a range of standardized shoe sizes as claimed in the present invention provide a structure on the outsole of a shoe that advantageously allows determination of a proper numerical shoe size for a person's foot. Accordingly, the claims of the present invention define new features of structure or new relations of printed matter to structure that give rise to a new and useful function and result. Therefore, Applicant respectfully submits that the claims of the present invention should be allowed.

For all of these reasons, the Office is respectfully requested to withdraw the rejections of claims 1-5, 7, 9-12, 14-18, 20, 22-25, 27-29, and 32-34 under 35 USC § 103(a).

Claims 8, 13, 21, 26, and 31—35 USC § 103(a)

The rejections of claims 8, 13, 21, 26, and 31 under 35 U.S.C. § 103(a) as being unpatentable over Berger in view of either Rosen or Sigoloff are respectfully traversed.

The Official Action states that Berger, as modified/discussed in the Official Action, shows a shoe sole and method of using such substantially as claimed except for providing a transparent layer over the bottom of the outsole, that Rosen or Sigoloff teaches providing a transparent layer on an outsole over an area of indicia, and that it would have been obvious to

provide a transparent layer as taught by Rosen or Sigoloff in the shoes and method of Berger to increase the durability and to make the indicia easier to read after the shoes have been worn.
(Official Action, para. 3.)

As discussed herein, Applicant respectfully submits that Berger fails to disclose all the claim limitations of claims 1, 12, 14, 25, 27, and 34 of the present invention, as amended, and is therefore deficient as a reference with respect to these independent claims. Claims 8, 13, 21, 26, and 31 depend from claims 1, 12, 14, 25, and 27, and are therefore also not obvious in view of Berger. Neither Rosen or Sigoloff cure the deficiencies of Berger as a reference by teaching or suggesting *"a range of standardized shoe sizes that approximate a size of the shoe"*, as in claims 1, 14, and 27, or *"a range of standardized shoe sizes . . . suitable for toddlers, pre-schoolers, girls, boys, women, or men"*, as in claims 12, 25, and 34. Thus, Applicant respectfully submits that claims 8, 13, 21, 26, and 31 are not obvious over Berger in view of either Rosen or Sigoloff.

For all of these reasons, the Office is respectfully requested to withdraw the rejections of claims 8, 13, 21, 26, and 31 under 35 USC § 103(a).

CONCLUSION

Applicant submits that a full and complete response has been made herein to the Official Action and, as such, all pending claims in this application are now in condition for allowance. Therefore, Applicant respectfully requests early consideration of the present application, entry of all amendments herein requested, withdrawal of all rejections, and allowance of all pending claims.

The Office is respectfully invited to contact J. Michael Boggs at (336) 747-7536, to discuss any matter relating to this application.

Respectfully submitted,

5/14/04
Date

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